

III. Remarks

A. Amendments To The Claims

Claims 8–9 and 11–14 have been amended to recite a preferred embodiment of the invention. In the embodiment now claimed, the protective colloids being covered are certain natural water-soluble polymeric protective colloids identified in the specification at page 7, lines 5–12. New claims 15–21 are directed to a specific protective colloid, gelatin.

B. Rejection Under 35 U.S.C. §102

Claims 8 and 11 are rejected under 35 U.S.C. §102(b) as being anticipated by S. Zhang and K.E. Gonsalves, J.Mater.Sci.Mater, Med. 8 (1997) 25 (henceforth referred to as the “Zhang et al. article”).

1. Examiner’s reasons for the rejection

The Examiner’s reasons for the rejection are as follows:

Regarding claim 8, Zhang et al. teach a solution (see Experimental [P]rocedures) comprising rod-like shaped hydroxyapatite particles having a length of 25 nm (see page 26 second col), wherein the hydroxyapatite crystallizes into hexagonal rhombic prisms (see Introduction) and polyacrylic acid (see page 25 Experimental Procedures section which recites “the starting precipitates without polyacrylic acid were prepared in a similar way” which teaches that the method described includes salt precipitates with polyacrylic acid. See also Figure 1, which is a micrograph of rod-like hydroxyapatite crystals with polyacrylic acid in the system) to which the calcium is bonded (see page 28). Regarding claim 11, Zhang et al. also teach . . . a method of making rod-like shaped hydroxyapatite particles comprising a 30ml solution in which 7.63g of calcium nitrite was dissolved and 2 g of polyacrylic acid (2 g of polyacrylic acid is at least .01% of the solution) was added (see Experimental [P]rocedures) such that the precipitated hydroxyapatite products were de-agglomerated as shown in Figure 1.

Examiner’s Action, page 3, lines 2–15.

2. Comparison between Applicants’ claimed invention and the Zhang et al. article

Applicants’ pending claims 8–14 recite for protective colloids, a specific group of natural water-soluble polymeric protective colloids disclosed in the Specification at page 7, lines 5–12. Claims 15–21 are directed to one species of the protective colloid recited in claims 8–14, namely, gelatin. Applicants note in passing that although claims 10 and 17 do not specifically recite this group of protective colloids, claims 10 and 17 are each dependent upon claims that

do recite the specific group of protective colloids referenced hereabove and, accordingly, are limited to the same group of protective colloids as the claims upon which they are dependent.

The Zhang et al. article does not exemplify or disclose any of the natural water-soluble polymeric protective colloids set forth in Applicants' claims 8 and 11. The Zhang et al. article employs polyacrylic acid, which Applicants indicate is a synthetic protective colloid. (See Specification at page 7, lines 13–16). Anticipation of claims 8 and 11 under 35 U.S.C. §102(b) is established only if (1) all of the elements in the invention as stated in these claims; (2) are identically set forth; (3) in the Zhang et al. article. *General Electric Co. v. Nintendo Co., Ltd.*, 179 F.3d 1350, 1356, 50 USPQ2d 1910, 1915 (Fed. Cir. 1999) (“A judgment of invalidity for anticipation requires that a single prior reference disclose every limitation in a patent claim.”) As stated above, the Zhang et al. article does not disclose any of the natural water-soluble polymeric protective colloids set forth in claims 8 and 11 or in Applicants' remaining claims 9–10 and 12–21. Accordingly, a rejection of Applicants' claims 8–21 under 35 U.S.C. §102(b) as being anticipated by the Zhang et al. article would be untenable and should not be made.

C. Joint Inventors

As noted by the Examiner, the application has more than one inventor. Applicants appreciate the Examiner's observations concerning the naming of Joint Inventors. Applicants confirm that either the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, or that the inventors were employed by Assignee and obligated to assign their inventions to the Assignee.

D. Rejection Under 35 U.S.C. §103

Claims 8–14 are rejected under 35 U.S.C. §103(a) as being unpatentable over the Zhang et al. article in view of International Application No. PCT/IB97/01634 to Rudin et al. (“the Rudin et al. application”). The Rudin et al. application was published as Published International Patent Application No. WO 99/20237 on April 29, 1999. Accordingly, for purposes of evaluating the applicability of the Rudin et al. application as a reference, its effective publication date is April 29, 1999, as set forth, for example, by Applicants in a Supplemental Information Disclosure Statement filed July 19, 2005.

In the present application, Applicants claim the benefit of International Application No. PCT/EP99/09683, filed December 9, 1999, and German Application No. DE 198 58 662.0, filed

on December 18, 1998. An appropriate claim of priority was made to both of those applications in a Preliminary Amendment filed with the application on June 8, 2001. Accordingly, if support for the subject matter set forth in claims 8–21 is provided in the International Application and the German Application from which Applicants claim priority, the Rudin et al. application cannot be a reference against Applicants' claims 8–21 because the December 18, 1998, filing date of the German application from which this application claims priority is more than four months before the April 29, 1999, publication date of the Rudin et al. application.

Applicants respectfully submit that the German Application provides disclosure supporting the natural water-soluble polymeric protective colloids set forth in claims 8–14 and the specific protective colloid, gelatin, set forth in claims 15–21. That disclosure is found in the publication of the German Application, German Published Application DE 198 58 662 A1, published June 21, 2000, at page 3, lines 26–31. A copy of German Published Application DE 198 58 662.0 A1 is attached hereto as **EXHIBIT A**. Similarly, International Application No. PCT/EP99/09683, from which this application claims priority, also discloses the group of natural water-soluble polymeric protective colloids set forth in Applicants' claims. That disclosure is in Published International Application No. WO 00/37033, published June 29, 2000, at page 6, lines 1–8. Published International Application No. WO 00/37033 is the publication of International Application No. PCT/EP99/09683. This Published Application is attached hereto as **EXHIBIT B**.

As the Rudin et al. application is not believed to be prior art against Applicants' claims 8–21 for the reasons set forth above, the rejection of claims 8–21 under 35 U.S.C. §103(a) as unpatentable over the Zhang et al. article, in view of the Rudin et al. application, is untenable and should not be made.

D. Double-Patenting

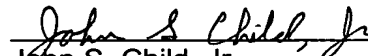
Claims 8–14 have been provisionally rejected under the judicially created Doctrine of Obviousness-Type Double Patenting as being unpatentable over claim 21 of co-pending Application No. 10/297,842, in view of International Application No. PCT/IB97/01634 to Rudin et al., referred to above as the Rudin et al. application. Inasmuch as the Rudin et al. application is not believed to constitute prior art against Applicants' claims 8–21, the provisional rejection of claims 8–14 under the judicially created Doctrine of Obviousness-Type Double Patenting appears to be untenable and should not be made against claims 8–21.

IV. Conclusion

It is believed that the above Amendment and Remarks constitute a complete response under 37 CFR § 1.111 and that all bases of rejection in the Examiner's Action have been adequately rebutted or overcome. A Notice of Allowance in the next Office Action is, therefore, respectfully requested. The Examiner is requested to telephone the undersigned attorney if any matter that can be expected to be resolved in a telephone interview is believed to impede the allowance of pending claims 8–21 of United States Patent Application Serial No. 09/868,379.

Respectfully submitted,

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